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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.												
10/731,800	12/09/2003	Raymond F. Watts	2003L008	4327												
7590 Infineum USA L.P. Law Department 1900 East Linden Avenue P. O. Box 710 Linden, NJ 07036-0710		12/28/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">GOLOBOY, JAMES C</td></tr></table> <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1797</td><td></td></tr></table> <table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>12/28/2007</td><td>PAPER</td></tr></table>		EXAMINER		GOLOBOY, JAMES C		ART UNIT	PAPER NUMBER	1797		MAIL DATE	DELIVERY MODE	12/28/2007	PAPER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/731,800		WATTS ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	James Goloboy		1797	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. The rejections of claims 3 and 5 under 35 USC 112, first paragraph have been withdrawn, as those claims are equivalent to claims 3 and 5 in the application as originally filed. Claim 3 remains rejected as anticipated by Sung. The rejection of claim 5 over Watts in view of Kinoshita and Bloch has been reinstated.

***Claim Rejections - 35 USC § 112***

2. Claims 1-2, 4, and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is adequately set forth in paragraph 3 of the office action mailed 7/12/07.

***Claim Rejections - 35 USC § 102***

3. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sung.

This rejection is adequately set forth in paragraph 4 of the office action mailed 7/12/07.

***Claim Rejections - 35 USC § 103***

4. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sung in view of Ohtani.

This rejection is adequately set forth in paragraph 5 of the office action mailed 7/12/07.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watts in view of Kinoshita and Bloch.

This rejection is adequately set forth in paragraph 8 of the office action mailed 8/15/06.

### ***Response to Arguments***

6. Applicant's arguments filed 10/12/07 have been fully considered but they are not persuasive.

Applicant argues that literal support for the claim language is not required to satisfy the written description requirement, and that the specification reasonably conveys to a person of ordinary skill in the art that the claimed composition does not require an aliphatic amine of the formula  $R-NH_2$  wherein R is a  $C_4-C_{30}$  hydrocarbyl group which does not contain a primary amine. It is not clear how this would provide support for the limitation of claim 1. If applicant intends to argue that the specification conveys that an R group that does contain a primary amine is not required, the examiner submits that conveying to one of ordinary skill in the art that a component is not required is not equivalent to conveying to one of ordinary skill in the art that the

component should be excluded. See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984).

Applicant further argues that Sung does not anticipate claims 1-4 and 6, because the product disclosed in Sung is not a "closed ring succinimide", and that the reactants and stoichiometry in the reaction of Sung are different than those of claim 1. However, neither claim 1 nor its dependent claims recite a closed ring succinimide or any particular stoichiometry. The claims recite a static friction reducing amount of a member selected from a group that includes the reaction product of maleic anhydride with certain primary aliphatic amines, and Sung clearly discloses a friction modifier that is the reaction product of maleic anhydride with an amine satisfying the limitations of claim 1.

The examiner's positions regarding the rejection of claim 5 over Watts in view of Kinoshita and Bloch are adequately set forth in the office actions mailed 8/15/06 and 2/23/07.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is 571-272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*James C. Goldrey*  
JCG



Glenn Caldarola  
Supervisor, Patent Examiner  
Technology Center 1700